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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,793	03/29/2001	Ulf Velten	003780-052	2640

7590

06/03/2003

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EXAMINER

WILSON, DONALD R

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 06/03/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,793

Applicant(s)

VELTEN ET AL.

Examiner

Donald R Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 and 20-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Restriction Requirement***

1. Applicant's election with traverse of the inventions of Group I, Claims 1-11 and 20-37, in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the search required for Groups II, III and IV would be substantially co-extensive with the search for the claims of Group I. This is not found persuasive because additional searches which would be required for Groups II-IV are not required for the Group I inventions. Further, the entire prosecution of the application is to be considered, not just the initial search. Applicant also traversed that the groups of invention are related by an intermediate final product relationship. It is argued that there is no basis for concluding that the intermediate products of the admixture, aqueous slurry, or cementitious compositions would lose its identity in the final product. As noted by applicant, an intermediate-final product relationship exists if the final product does not show the characteristics of the intermediate product. However, the admixtures of the Group II inventions include mixtures of at least two polymers, wherein the identity of the first polymer is thereby changed and different than the first polymer by itself. As to the cementitious compositions, it would be expected that the cement would chemically and physically interact with the cement such that the modified acrylic polymers lose their identity. However, the Examiner will agree to rejoin the inventions of groups II and IV, i.e., Claims 12-14, 18-19 and 38, in any future prosecution of those claims in a continuation or divisional application.
2. The requirement is still deemed proper and is therefore made FINAL. Claims 12-19 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Election of Species Requirement

3. This elected group of inventions in this application contains claims directed to the following genera of patentably distinct species of the claimed invention:
 - a. polyacrylic acid monomer units as represented by formula A in Claim 2,

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- b. polyalkyleneglycol monoalkyl ether acrylate ester monomer units as represented in formula B in Claim 2¹,
 - c. α -acrylamido-polyalkylene- ω -alkyl ether monomer units as represented by C in Claim 2, including the option of none present, and
 - d. acrylamide monomer units as represented by D in Claim 2, including the option of none present.
4. As appropriate to the elected group of inventions applicant is required under 35 U.S.C. § 121 to elect a **single ultimate** disclosed specie for each of the above genera for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Where specific species are not identified in the claims applicant should elect a specific specie from the specification. An example of an acceptable election is (a) acrylic acid unit, (b) poly(ethylene glycol monomethyl ether acrylate unit, (c) none present, (d) N,N-dimethylacrylamide unit. An alternative method of election is to identify an Example which collectively exemplifies the elected species. Currently, Claims 1-10 appear to be generic to the above genera of species.
5. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion to Restriction/Election Requirement

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

¹ Although the language and/or is used for component B, it must be present as "o" is defined in the claim as being (0.1 to 0.95).

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9. A telephone call was made to Mr. George Lesmes on 5/30/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'DRW', with a long horizontal line extending to the right.

Donald R Wilson
Primary Examiner
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